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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/896,874	06/29/2001	Lawrence Y. Fang	13615.40USU1	1026

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EXAMINER

KUMAR, SHAILENDRA

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 01/31/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/896,874

Applicant(s)  
Fang et al

Examiner  
Shailendra Kumar

Art Unit  
1621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 29, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-147 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-147 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-30 and 144-147, drawn to substituted amine and composition, classified in class various, subclass various.
  - II. Claims 31-35, drawn to a protected compound, classified in class various, subclass various.
  - III. Claims 36-40, drawn to different class of protected compounds, classified in class various, subclass various.
  - IV. Claims 41-45, drawn to amino compounds with protecting group, classified in class various, subclass various.
  - V. Claims 46-50, drawn to yet another different protected compounds, classified in class various, subclass various.
  - VI. Claims 51-53, drawn to amino compounds, classified in class various, subclass various.
  - VII. Claims 54-94, drawn to method of treatment, classified in class 514, subclass various.
  - VIII. Claims 95-114, drawn to method of inhibiting beta secretase activity, classified in class 514, subclass various.
  - IX. Claims 115-136, drawn to method of inhibiting cleavage of amyloid precursor protein, classified in class 514, subclass various.
  - X. Claims 137-143, drawn to a kit, classified in class 206, subclass various.

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2. The inventions are distinct, each from the other because of the following reasons:

The ten groups of invention above are drawn to chemically divergent subject matter, which are patentably distinct for the reasons of classification and divergent subject matter. A reference anticipating one of the above group may not render the other obvious under 35 USC 103. Hence the restriction requirement is deemed proper.

Additionally applicants need to elect a single disclosed species if they elect any of groups I to VI and a single compound with single disclosed method of treatment if they elect group VII to IX. Applicants also need to point out to as to what claims read on the elected species.

3. In view of the complexity of the restriction requirement, a written restriction is hereby made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

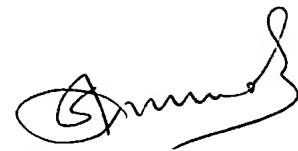
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S.Kumar whose telephone number is (703) 308-4519.



SHAIENDRA KUMAR  
PRIMARY EXAMINER  
GROUP 1200

S.Kumar

January 28, 2002